

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claims 2-6, 8, 11-15 and 17 have been amended at least partly in response to issues raised in the Office Action. New claims 18 and 19 are directed to subject matter deleted from claims 4 and 13 in response to the Office Action.

Claims 4, 8, 13 and 17 were objected to for the reasons set forth on page 2, second paragraph, of the Office Action. In response, Applicants have amended the claims to eliminate the objectionable terminology. Other claims were amended to correct existing terminology. For example, claims 2, 4, 11 and 13 were amended to change "hydrocarbon" to --comonomer-- since some of the suitable compounds for copolymerization with carbon monoxide are not hydrocarbons.

In view of the above amendments, the objections to the claims have been obviated and should be withdrawn. Such action is earnestly requested.

Claims 1-17 were rejected under 35 U.S.C. §102(e) as anticipated by or, alternatively, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,203,727 to Babinec et al. for reasons provided on pages 4-5 of the Office Action.

Reconsideration and withdrawal of these rejections are respectfully requested for at least the following reasons.

Babinec et al. '727 relates to an intrinsically conducting polymer doped with at least two different dopants having different molecular weights. The resultant conductive polymer composition may be added to a matrix material selected from thermoplastic or thermoset polymers, latexes and sol gels (claim 8). The lengthy list

of suitable thermoplastic polymers (column 6, line 53 to column 7, line 39) includes commercial copolymers of α -olefins and carbon monoxide (column 7, lines 3-4). The matrix polymers disclosed in the working Examples are polycarbonate, polystyrene, polyolefin, polyvinyl chloride and polymethylmethacrylate. Thus, polyketone polymers are not used in the working Examples of the reference and are only mentioned as a suitable matrix polymer in a lengthy list that encompasses literally hundred of polymeric materials.

A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913,1920 (Fed. Cir. 1989).

Applicants respectfully submit that the presently claimed invention is not set forth in the reference in as complete detail as is contained in the claims. Thus, Babinec et al. '727 does not specifically mention a conductive blend of a major amount of a polyketone polymer and a minor amount of a conducting organic polymer, nor does the reference mention any specific comonomers with carbon monoxide. Claim 2 is directed to a linear alternating copolymer, claims 3 and 5 to a terpolymer, claim 18 to monomers containing heteroatoms, etc. These features are not disclosed in the reference.

For at least these reasons, the §102(e) rejection over Babinec et al. '727 should be withdrawn.

be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The motivation to modify the prior art reference must flow from some teaching in the art that suggests the desirability or incentive to make the modifications needed to arrive at the claimed invention. In re Napier, 55 F.2d 610,613; 34 U.S.P.Q.2d 1782,1784 (Fed. Cir. 1995). Obviousness cannot be established by modifying the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the claimed modification. In re Geiger, 815 F.2d 686,688; 2 U.S.P.Q.2d 1276,1278 (Fed. Cir. 1987).

The invention of Babinec et al. '727 relates primarily to the production of a doped intrinsically-conductive polymer using a combination of a lower molecular weight dopant and a higher molecular weight dopant. The selection of any particular matrix polymer is not part of the invention of the reference. There is no teaching or suggestion in this reference which would motivate those of ordinary skill to select a polyketone copolymer of carbon monoxide and at least one comonomer as opposed to any of the other compounds listed in claim 8 as a suitable matrix material.

The fact that a claimed species is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness (In re Baird, 16 F.3d 380; 29 U.S.P.Q.2d 1550). To establish a *prima facie* case of obviousness in a genus-species chemical composition situation, it is essential that some motivation be found to make the claimed invention in light of the prior art teachings. Applicants

submit that there is no teaching or suggestion in Babinec et al. '727 that would have motivated those of ordinary skill in this art to select a polyketone copolymer of carbon monoxide and comonomer from all the possible permutations and combinations encompassed by the disclosure of the reference. Nor would there have been a reasonable expectation of success by selecting polyketone copolymers in the compositions of Babinec et al. '727.

For at least these reasons, the alternative §103(a) rejection based on Babinec et al. '727 should be withdrawn. Such action is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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